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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/245,347	02/05/1999	CHIYO AKAMATSU	520.36900X00	4824
24956	7590	05/31/2006	EXAMINER	
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			HSU, ALPUS	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/245,347

Applicant(s)

AKAMATSU ET AL.

Examiner

Alpus H. Hsu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/17/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The indicated allowability of claims 33-37 and 47 is withdrawn in view of the newly discovered 112, first paragraph problem. Rejections based on the 112, first paragraph follow.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 33-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claimed subject matters of having “a controller for controlling an output of said output circuit, so as to manage a **number** of said other apparatuses, through which the program can be viewed or recorded simultaneously, wherein said controller determines **the number** of said other apparatuses, wherein said controller determines whether said other apparatuses are regularly certified apparatuses which can receive said program, and wherein said controller restricts **the number** of said other apparatuses, to which said output circuit can output said program, to the regularly certified apparatuses, and restricts **the number** of the regularly certified apparatuses which can simultaneously view or record the program being output to be less than or equal to a **predetermined number**” as in claims 33-43, and the steps of “managing a **number** of said other apparatuses, through which said data received from the source can be viewed or recorded simultaneously, by determining **the number** of said other apparatuses, determining whether said other apparatus are regularly certified apparatuses which can receive said data, and restricting said other apparatuses, to which the data is to output, to the regularly

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certified apparatuses; and restricting **the number** of the regularly certified apparatuses which can simultaneously view or record the data being output to be less than or equal to a **predetermined number**" as in claims 44-49, were not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

To be more specific, according to figure 5 and page 18, line 26 to page 19, line 26 of the specification disclosure, there are two numbers to be determined, one for **the number of viewing contracts** indicating a number of the output apparatuses on which the broadcast program data can be seen or viewed at the same time by the user through the receiving contract channel, and the other for **the recording contract number** indicating the number of the recording apparatuses on which the broadcast program data can be outputted to be recorded at the same time through the receiving contract channel, which is contradict with the claimed subject matter of determining a number of said other apparatuses, through which said data received from the source can be viewed or recorded simultaneously, determining **the number** of said other apparatuses whether said other apparatus are regularly certified apparatuses which can receive said data, and restricting **the number** of the regularly certified apparatuses which can simultaneously view or record the data being output to be less than or equal to a **predetermined number**".

4. Claims 33-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 33, lines 12 and 14, "the number" has no clear antecedent; line 16, it is confusing for reciting "a predetermined number". Is it referring to any numbers as in lines 6, 12 or 14?

In claim 39, line 9, "whether" should be deleted; line 15, "said predetermined number" lacks antecedent basis.

In claim 44, line 10, "the number" has no clear antecedent; line 12, it is confusing for reciting "a predetermined number". Is it referring to any numbers as in lines 4 or 10?

5. Claims 33-49 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st and 2nd paragraphs, set forth in this Office action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nicholson, Inoue et al. '280, '141' & '881, and Lee et al. '299 & '481 are additionally cited to show the feature of techniques for selectively inhibiting TV programs recording and/or reproducing which are not authorized for viewing similar to the claimed invention.

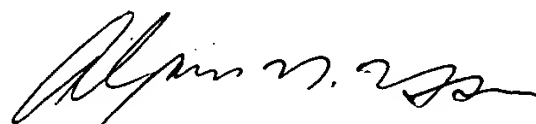
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alpus H. Hsu whose telephone number is (571)272-3146. The examiner can normally be reached on M-F (5:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571)272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AHH



Alpus H. Hsu
Primary Examiner
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